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EXAMINER

WALKE, AMANDA C

ART UNIT	PAPER NUMBER
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1752

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Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 20040608

Application Number: 09/806,360
Filing Date: March 29, 2001
Appellant(s): JEGANATHAN ET AL.

Tyler A. Stevenson
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 3/29/2004.

MAILED
JUN 22 2004
GROUP 1700

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying that there are no known related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that there are three groups of claims that stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8). The groups are:

Claims 1-10

Claim 12, and

Claims 14 and 15.

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(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

4,325,863	Hinsken et al.	4-1982
5,597,854	Birbaum et al.	1-1997

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-10, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Birbaum et al (5,597,854).

Birbaum et al disclose a silver halide photographic material containing a stabilizer meeting the structural limitations of the present claims (column 29, lines 39-51, "14", column 34, lines 31-65), and a method for preparing and processing the silver halide photographic material. The stabilizers are employed for stabilizing organic materials against the harmful effects of light, oxygen, and/or heat (see abstract). The compound may be added to a layer containing a UV absorber such as a protective layer or a layer between the red and green sensitive emulsion layers (an interlayer). The green sensitive emulsion layer contains a magenta coupler which is a pyrazolopyrazole, pyrazolotriazole, or pyrazolotetrazole (column 34, line 1 to column 35, line 57). From the weight of the polymer coating composition in column 59, and the teaching in column 29 that the stabilizer may be added in an amount of 0.1 to 5 % by wt of the polymer (s), the amount of stabilizer added to the layer (s) would fall within the scope of the present claim 8.

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Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Birbaum et al in view of Hinsken et al (4,325,863).

Birbaum et al has been discussed above, but fails to specifically describe a compound meeting the limitations of the present formula VI. However, note that Birbaum specifically reference cites Hinsken et al as describing suitable benzofuranone compounds. Those exemplified by Hinsken et al teach that the present R2 and R4 groups may contain pentyl groups (as in the present formula IV) and teach that they are equivalent to butyl groups (see compound 8).

Given the teaching of Hinsken et al that suitable substituents for positions R2 and R4 include pentyl groups, it would have been obvious to one of ordinary skill in the art to prepare the material of Birbaum et al using the benzofuranone compounds described in "14" of column 29 replacing the butyl group with a pentyl group given that they are taught to be equivalent by the reference, with reasonable expectation of forming a material having increased protection against light, oxygen, and/or heat.

(11) Response to Argument

Appellant has argued that the benzofuranone compounds of Birbaum have not been taught to function as oxidized developer scavengers. As discussed above, the compounds of Birbaum meet the structural limitations of the present claims, thus it is the position of the examiner that when added to the material these compounds would function in the same manner as those presently claimed regardless of the purpose of addition given by the reference. The reference teaches that in the process of preparing and processing the described silver halide photographic material, the reference teaches that the stabilizer compounds added to the material

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are added to stabilize the organic material against damage by light, oxygen and/or heat, which comprises adding a compound of the formula I thereto as stabilizer, and to the use of compounds of the formula I for stabilizing organic material in combination with other stabilizer compounds including benzofuranones. Furthermore, the well known textbook by T.H. James titled "The Theory of the Photographic Process, 4th Edition", clearly defines stabilizers and teaches that stabilizers have many possible actions including stopping the migration of silver ions and interacting with other emulsion ingredients and/or protect the silver halide from their detrimental effects. James further teaches that good properties for stabilizers include low oxidizability, restraining fog formation, restrain the developer, and the ability to immobilize silver ions. Specifically, the property of restraining the developer is relevant here, as this would keep the developer from "bleeding" into areas or layers where the developer was not intended to migrate and develop (page 398, column 2 to page 399, column 2). Thus based on the definition given in James, it is clear that the applied references teach and anticipate the instantly claimed invention. Absent evidence to the contrary, the examiner maintains her rejection.

Appellant has also argued that the examiner has used impermissible hindsight in formulating the 102 rejection as the Birbaum reference's teaching include a great number of compounds. However, the reference lists only 14 different types of stabilizer compounds although many compounds may fall under each of the 14 categories. It is the examiner's position that one of ordinary skill in the art would have immediately envisaged using a compound from any of the 14 different categories, thus the examiner maintains her position. For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,

Amanda C Walke
Examiner
Art Unit 1752


ACW

June 14, 2004

Conferees

Mark Huff

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